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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,411	09/24/2003	Richard Dwyer Hiserodt	IFF-66	8392
48080	7590	05/10/2005	EXAMINER	
INTERNATIONAL FLAVORS & FRAGRANCES INC.			COE, SUSAN D	
521 WEST 57TH ST			ART UNIT	
NEW YORK, NY 10019			PAPER NUMBER	

1654

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/671,411	<b>Applicant(s)</b> HISERODT ET AL.	
	<b>Examiner</b> Susan D. Coe	<b>Art Unit</b> 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/4/05; 3/1/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed March 1, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claim 9 has been added.
3. Claims 1-9 are pending.

#### *Claim Rejections - 35 USC § 102*

4. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 87/03803.

Applicant's claims are drawn to a composition comprising a plant extract that contains monomenthyl succinate. The plant sources of the extract are specifically claimed as *Lycium barbarum* or *Mentha piperita*. Synonyms for *L. barbarum* include *Lycium halimifolium* (see <http://davesgarden.com/pdb/go/63945>; [www.orient-hospital.com/Eng/gouji.htm](http://www.orient-hospital.com/Eng/gouji.htm); and [www.biosurvey.ou.edu/shrub/lyba4.htm](http://www.biosurvey.ou.edu/shrub/lyba4.htm)). The common name for *L. barbarum* is wolfberry (see [www.orient-hospital.com/Eng/gouji.htm](http://www.orient-hospital.com/Eng/gouji.htm)). The method for making the extract comprises extracting the plant biomass with ethanol and filtering the extract to remove the biomass. The extraction takes place between 10 to 24 hours. The filtered solution contains the monomenthyl succinate.

WO '803 teaches a method of making a composition from the plant *Lycium halimifolium*. The plant is extracted with ethanol and then filtered to obtain the extract solution. The extraction can take place between 12 to 36 hours (see claims 5 and 8).

The reference does not specifically teach that the plant extract contains monomenthyl succinate. However, the reference teaches making an extract from the same plant using the same

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solvent and same extraction steps as claimed. Thus, the reference extract would inherently have to contain all of the same components as the claimed extract including monomenthyl succinate.

If the reference extract does not contain monomenthyl succinate then applicant's invention would not function as claimed.

5. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,776,461.

US '461 teaches a method of making an extract from peppermint (*Mentha piperita*). The plant is extracted in ethanol for at least 20 hours then the extract is separated (see column 10, line 63 - column 7, line 11).

The reference does not specifically teach that the plant extract contains monomenthyl succinate. However, the reference teaches making an extract from the same plant using the same solvent and same extraction steps as claimed. Thus, the reference extract would inherently have to contain all of the same components as the claimed extract including monomenthyl succinate. If the reference extract does not contain monomenthyl succinate then applicant's invention would not function as claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 87/03803.

The teachings of WO '803 are discussed above. However, this reference does not specifically teach performing the extraction for all of the times claimed by applicant. The reference does teach that a wide variety of extraction times can be used (see claims 7 and 8). Thus, the reference teaches that extraction time is a variable that can be optimized in order to best achieve the extraction as set forth by the reference. In carrying out this routine optimization, a person of ordinary skill in the art would reasonable arrive at the extraction times claimed by applicant.

7. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.



420-05

Susan D. Coe  
Primary Examiner  
Art Unit 1654